THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte THOMAS A. CROWELL, J. JEFFRY HOWBERT and JOHN S. WARD

Appeal No. 1996-0721
Application No. 08/036,640[1]

ON BRIEF

Before GARRIS, HANLON and PAK, Administrative Patent Judges.

PAK, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the examiner's final rejection of claims 14 through 26 and 28, which are all of the claims pending in the application.

[1] Application for patent filed March 24, 1993. According to the appellants, the application is a division of Application No. 07/554,218, filed July 17, 1990, now Patent No. 5,216,026, issued on June 6, 1993.

Claim 14, the broadest claim in the application, reads as follows:

pharmaceutically acceptable salts thereof.

$(CH_2)_n$ where n is 1-3, and Z is oxygen or sulfur; and

f) RZR_1- where R is phenyl or a C_1-C_3 alkyl, R_1 is

e) a C_4-C_8 cycloalkyl; or

hydrogen or chloro and when X_1 is promo then X_2 is not hydrogen;

that when the alkenyl is C_3, and X_1 is chloro then X_2 is not

q) phenyl-unsubstituted C_3-C_4 alkenyl with the proviso

c) phenyl-unsubstituted C_1-C_4 alkyl;

p) a C_3-C_7 alkenyl;

purly X_1 is promo or X_2 is other than hydrogen;

g) a C_3-C_7 alkyl with the proviso that when B is n-

B is:

wherein

X_2 is hydrogen, halo or CF_3; and

X_1 is halo;

wherein

neoplasms in mammals having the formula

14. A compound useful in the treatment of susceptible

As evidence of obviousness, the examiner relies on the following prior art:

McLamore et al. (McLamore) (Commonwealth of Australia)	228,642	Jun. 09, 1960
Korger et al. (Korger) (Canada)	601,640	Jul. 12, 1960
Lucius & Bruning (Lucius)[2] (Denmark)	93,622	Sep. 10, 1962

As evidence of nonobviousness, appellants rely on the following literature:

Ruschig et al. (Ruschig)[3], Arzneimit. Forsch., 8, 448 (1958).

Claims 14 through 26 and 28 stand rejected under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Korger, McLamore and Lucius.

We reverse.

The Korger reference teaches "valuable medicaments showing a blood sugar reducing effect compounds of the general formula

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[2] Our reference to this Danish patent is to the corresponding English translation of record.

[3] Our reference to this literature is to the corresponding English translation of record.

$$R\text{-}SO_2\text{-}NH\text{-}CO\text{-}NH\text{-}R_1$$

in which" R is, ***inter alia***, a substituted or unsubstituted phenyl, aliphatic or cycloaliphatic hydrocarbon radical and R_1 is

$-(CH)_nC_6H_5$. See column 1, lines 19-51. According to the examiner (Answer, page 3):

> The sole difference between [sic, the] herein recited claims and the [Korger] reference appears to be in the definition of R_1 in the reference.

To remedy this deficiency of the Korger reference, the examiner relies on the disclosures of McLamore and Lucius. McLamore describes medicinal agents for reducing blood sugar levels having a formula

$$RSO_2NHCONHR',$$

wherein R' is "a lower alkyl, lower alkenyl or cycloalkyl group or it is an aryl group." See pages 1 and 2. Similarly, Lucius describes compounds for lowering blood sugar having a formula $RSO_2NHCONHR^1$,

wherein R^1 is "saturated or unsaturated alkyl, cycloalkyl, cycloalkylalkyl, phenylalkyl or phenyl group..." See page 2. Nowhere do these references teach, or would have suggested, employing the claimed halophenyl radical as R_1 of the general

formula described in the Korger reference. Nor has the examiner explained why the above disclosures of McLamore and Lucius would have led one of ordinary skill in the art to employ the claimed halophenyl radical in the general formula described in the Korger reference.

Even were we to read R' in McLamore as including all of the species described at page 2 therein (which we do not) as appears to be suggested by the examiner (Answer, page 4), we determine that McLamore would not have suggested the employment of the claimed halophenyl radical as R_1 of the general formula described in the Korger reference. Specifically, the Ruschig reference relied on by appellants, like Korger, teaches preference for $(CH)_nC_6H_5$ as R_1 of the general formula described in Korger for lowering blood sugar. See page 5, together with Brief, page 6. In addition, the Ruschig reference teaches that the use of a substituted or unsubstituted phenyl radical as R_1 of the general formula described in Korger would render the formula ineffective for lowering blood sugar and render the formula extremely toxic for humans. See Brief, page 6, together with Ruschig, pages 4 and 5. Thus, we agree with appellants that one of ordinary

skill in the art would have been led away from substituting the claimed halophenyl for $(CH)_nC_6H_5$ of the generic formula described in Korger.

Accordingly, we reverse the examiner's decision rejecting claims 14 through 26 and 28 under 35 U.S.C. § 103 as unpatentable over the combined disclosures of Korger, McLamore and Lucius.

As a final point, we note that U.S. Patent 2,979,437, Chemical Abstracts, Farmaco. Ed. Sci. and Bulletin De La Societe Chimique referred to at page 2 of the specification appear to fully describe compounds which are embraced by the claimed formula. Upon return of this application, the examiner is to determine whether they affect the patentability of the claimed subject matter under 35 U.S.C. § 102 or § 103.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED

BRADLEY R. GARRIS)
Administrative Patent Judge)

ADRIENE LEPIANE HANLON Administrative Patent Judge	BOARD OF PATENT APPEALS AND INTERFERENCES
CHUNG K. PAK Administrative Patent Judge	

jrg

Paul J. Gaylo
Eli Lilly and Company
Patent Division/PJG
Lilly Corporate Center
Indianapolis, MN 46285